

... the independent claims have been amended to exclude thermal dye transfer, as clearly supported by the specification. Regarding the method claim, the film of the present invention is scanned, thus inherently excluding the use of dye transfer receiving layer.

The Examiner then refers to page 59 of the present application, first paragraph, which discloses that "it is possible to transfer the released mobile dyes to a receiver where they are immobilized in a mordant layer. The image bearing receiving can then be scanned."

The Examiner states: "Therefore, the negative limitation presented in the claims was not supported by the specification as originally filed, and it raises the issue of new matter."

This rejection is strenuously traversed. Although Applicants' invention was originally disclosed as being useful in a thermal dye transfer element, it was also disclosed as being useful in a non-thermal dye transfer element. In fact, the preferred embodiments illustrated by the Examples all refer to a non-thermal dye transfer element. It is clear from the overall specification that a non-thermal dye transfer element was mainly contemplated. Applicants' amendment, therefore, merely excludes one alternative embodiment, a relatively minor one only briefly mentioned, and claims different embodiment, a relatively major embodiment that is the focus of much of the application. That is not new matter. The disclosure clearly envisions non-thermal dye transfer elements as the main alternative. Regarding the method of the invention, the film is scanned, not a receiver separate from the film as in a thermal dye transfer system. The claims have merely been amended to exclude an embodiment of the invention that accidentally bears a superficial resemblance to an embodiment in the prior art, but which prior art does not teach the invention, as detailed in Applicants' previous amendment.

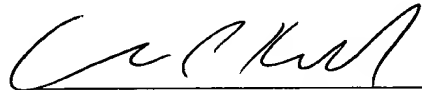
MPEP 2173.05(i) states as follows with respect to negative limitations:

If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims...the mere absence of a positive recitation is not a basis for an exclusion.

See also Ex Parte Parks, 30 USPQ2d 1234 (Bd. Pat. App. & Inter. 1993) wherein it is stated: "... it cannot be said that the originally filed disclosure would not have conveyed to one having ordinary skill in the art the concept of effecting decomposition at an elevated temperature in the absence of a catalyst [even though there was no discussion of a catalyst in the disclosure]."

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,



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